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| Notice of Allowability | Application No. | Applicant(s) |
| | 09/980,718 | BOSCH ET AL. |
| | Examiner | Art Unit |

William P. Fletcher III

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to the amendment & response after-final filed 6/7/2004.

2. The allowed claim(s) is/are 31-34,36 and 37.

3. The drawings filed on _____ are accepted by the Examiner.

4. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of the:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

6. CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) hereto or 2) to Paper No./Mail Date _____.

(b) including changes required by the attached Examiner's Amendment / Comment or in the Office action of
Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- 1. Notice of References Cited (PTO-892)
- 2. Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3. Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
- 4. Examiner's Comment Regarding Requirement for Deposit
of Biological Material
- 5. Notice of Informal Patent Application (PTO-152)
- 6. Interview Summary (PTO-413),
Paper No./Mail Date _____.
- 7. Examiner's Amendment/Comment
- 8. Examiner's Statement of Reasons for Allowance
- 9. Other _____.

WPF 6/17/2004

William Phillip Fletcher III
Patent Examiner, USPTO
Group Art Unit 1762

DETAILED ACTION

Response to Amendment

1. Applicant's amendment after-final, filed 6/7/2004, has been entered. This amendment overcomes the rejections under 35 U.S.C. § 112, 2nd Paragraph, set-forth in the Office action mailed 4/12/2004.

Response to Arguments

2. Applicant's arguments, see the amendment and response after-final, filed 6/7/2004, with respect to the rejections under 35 U.S.C. § 103(a), set-forth in the Office action mailed 4/12/2004, have been fully considered and are persuasive. These rejections have been withdrawn.

3. With respect to product-by-process claims 35 and 38, “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).¹

Panush (US 4,551,491 A), for example, teaches a substrate coated with a cellulose ester-containing polyurethane resin base coat and a clear coat. While the base coat is *solvent-based*, the finished product, in which the solvent has been removed, is identical to that claimed by applicant in claims 35 and 38, deposited from a water-based base coat. Consequently, claims 35 and 38 are unpatentable.

¹ See MPEP § 2113.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jacqueline Cohen (Reg. No. 51,574) on 6/17/2004.

The application has been amended as follows:

Claim 35 (canceled).

Claim 38 (canceled).

Allowable Subject Matter

5. Claims 31-34, 36, and 37 are allowed.
6. The following is an examiner's statement of reasons for allowance: Applicant's arguments, mentioned in paragraph 2 above, are persuasive. Wenzel and Das are the closest prior art. While the *background teaching* of Das clearly indicates that it is known to use cellulose ester-containing base coats in color-plus clear applications, the prior art referenced by Das deals exclusively with acrylic resins, not polyurethane resins. There is neither teaching nor suggestion here of utilizing a polyurethane base coat. The *invention* of Das does teach that the

base coat may contain a polyurethane resin dispersion, but there is neither teaching nor suggestion to substitute the composition of Wenzel therefore. Lastly, Das explicitly teaches away from cellulose ester amounts less than 20 wt.-% (9:26-31).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

WPF 6/7/2004
William P. Fletcher III
Examiner
Art Unit 1762